

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following remarks.

I. Status of the Claims

Claim 27 is currently pending in the application. Claim 29 is canceled without prejudice to or disclaimer of the subject matter therein. Claims 1-26, 28 and 30-45 were previously cancelled.

Claim 27 is amended to recite an isolated promoter comprising SEQ ID NO: 10. Support for the amendment to claim 27 may be found throughout the specification and in particular in Example 5 at page 24, lines 1-4 of the specification.

This amendment does not introduce any new matter into the application. Claim 27 is amended to address the concerns raised in the Office Action with regard to patentable subject matter, and place the application in condition for allowance or, at least, in better condition for appeal. Entry of this amendment after final is therefore respectfully requested.

II. The Telephone Interview with the Examiner

Applicants wish to thank Examiner Baum for the courtesy extended to Applicants' representative during the telephonic interview held on February 19, 2008. The claim presented herein and the following remarks reflect the issues that were discussed and agreed upon during the telephone interview.

III. The Rejections Under 35 U.S.C. § 112, First Paragraph

1. New Matter

The Office Action, at pages 2-3, rejects claim 29 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action alleges that the specification does not explicitly point out the two GGTAGGTA binding sites within SEQ ID NO: 10, and contends that these two binding sites were not contemplated at the time of filing. Applicants respectfully traverse this ground of rejection.

Solely to advance prosecution, and not in acquiescence with the rejection, the foregoing cancels claim 29. Accordingly, the rejection is moot. Reconsideration and withdrawal of this ground of rejection are therefore respectfully requested.

2. Written Description

The Office Action, at pages 3-4, maintains the rejection of claim 29 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Office Action alleges that the specification does not disclose a representative number of sequences comprising a fragment of SEQ ID NO: 10 which comprise two GGTAGGTA binding sites and have promoter activity. Further, the Office Action contends that the specification does not disclose essential regions, other than the two binding sites, which are required for promoter activity. Applicants respectfully traverse this ground of rejection.

Nevertheless, as stated above, solely to advance prosecution, and not in acquiescence with the rejection, the foregoing cancels claim 29. Thus, the rejection is moot. Reconsideration and withdrawal of this ground of rejection are therefore respectfully requested.

3. Enablement

The Office Action, at pages 4-5, maintains the rejection of claim 29 and rejects claim 27 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Office Action recognizes that the specification discloses SEQ ID NO: 10 and a method for isolating SEQ ID NO: 10, but contends that the specification allegedly fails to disclose whether SEQ ID NO: 10 comprises the elements necessary for promoter activity. Applicants respectfully traverse this ground of rejection.

As stated above, solely to advance prosecution, and not in acquiescence with the rejection, claim 29 is canceled and claim 27 is amended to recite an isolated promoter comprising SEQ ID NO: 10.

In the current application, Applicants have sufficiently disclosed the invention to meet the enablement requirement. In fact, the specification discloses that SEQ ID NO: 10 corresponds to the 5' flanking region of the loblolly pine 4CL3B gene (*see* legend to Figure 6 at page 5, as amended in the Amendment and Reply filed on August 29, 2007). Further, Example 5 in the specification clearly teaches the following with regard to the claimed sequence:

A 1.6 kb fragment and a 0.6 kb fragment for PAL gene and a 2.3 kb fragment (4CL1B) and a 0.7 kb fragment (4CL3B) for the 4CL gene were cloned, sequenced and *found to contain promoter regions for all three genes*. See FIG. 6 (SEQ ID NO: 10), 7 (SEQ ID NO: 11) and 8 (SEQ ID NO: 9).

Id at page 24, lines 1-4 of the substitute specification (emphasis added).

Accordingly, the specification discloses that SEQ ID NO: 10 comprises a 4CL promoter region that is essential for correct promoter activity, and thus provides enablement for the invention as claimed.

Thus, the rejection is moot. Reconsideration and withdrawal of this ground of rejection are therefore respectfully requested.

CONCLUSION

All of the stated grounds of rejection have been properly traversed or rendered moot. Thus, the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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